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TRAVERSAL REMARKS IN SUPPORT OF REJOINDER

Before addressing the restriction, Applicant wishes to note that the claimed invention claims priority of a Provisional Application filed December 3, 1999. A Non-provisional Application was filed on November 9, 2000, yet the current Office Action mailed July 28, 2003, is the first action issued. Therefore, the claimed invention has been pending as a Non-provisional Application for over two-and-a-half years and still has not received an action on the merits. Applicant respectfully requests an expeditious action on the merits.

In the Office Action mailed July 28, 2003, the Examiner set forth a four-way restriction of claims 1-29. Specifically, the Examiner identified claims 1-10 as being drawn to a method for designing an electronic transaction system classified in 705. Claims 11-16 were found to be drawn to a method of forming a proposal for doing business on a global communication network which was also classified in class 705. Claims 17-22 were deemed to be drawn to a method of conducting electronic commerce over a global network which was also classified in class 705. The Examiner then identified claims 23-29 as being drawn to a method of electronic sale of medical devices which was also classified in class 705. The Examiner concluded that each of the above-identified inventions were distinct from each other because they are "related as subcombinations disclosed as usable together in a single combination." The Examiner simply concluded that "each invention has separate utility such as the electronic sale of automobile parts or other commodity." The Examiner then states that the restriction is proper simply by stating, without support, that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. Applicant respectfully disagrees with the Examiner's conclusion and believes the Examiner has failed to meet the burden under the MPEP, CFR, and substantive case law, required to substantiate the restriction and has incorrectly classified the Groups.

MPEP §803 provides two separate criteria for a proper requirement for restriction between patentably distinct inventions. Namely, the inventions must be independent or distinct as claimed and there must be a serious burden on the Examiner if restriction is

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required. MPEP §808.02 sets forth the appropriate guidelines for determining if a serious burden would be placed on the Examiner absent restriction. Specifically, to establish reasons for insisting upon restriction, the Examiner must show by appropriate explanation (1) separate classification of the identified inventions, (2) that the inventions have acquired a separate status in the art, or (3) that the inventions require differing fields of search.

Regarding the Examiner's conclusions as to the separate utility of each of the identified groups, Applicant respectfully believes the Examiner has failed to consider the subject matter of the claims of each Group as a whole as well as the similarities and subject matter between each of the identified Groups.

The Examiner cites MPEP §806.05(d) but does not meet the burden required under the section. Specifically, MPEP §806.05(d) is applicable where two or more claimed subcombinations are usable together in a single combination, and can be shown to be separately usable. MPEP §806.05(d) requires that "[t]he examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." However, the Examiner only states that "Groups I, II or III have separate utility such as the electronic sale of automobile parts or other commodity." This statement does not "show, by way of example, that one of the subcombinations has utility other than in the disclosed combination."

It appears that the Examiner is simply comparing the elements of the independent claims rather than the Groups. That is, the Examiner is asserting that Groups I, II, and III have separate utility, as in the electronic sale of automobile parts, than claim 23 because claim 23 calls for "a method of electronic sale of medical devices." However, when reviewing the Groups as a whole, it is apparent that, contrary to the Examiner's assertions, Groups I, II, and III do not have separate utility as in the electronic sale of automobile parts or other commodities. Specifically, claims 3, 4, 5, 8, and 10 of Group I all call for medical devices/equipment. Similarly, claims 13 and 15 of Group II call for selling medical devices and the delivery of medical devices, respectively. Claims 19 and 20 of Group III also call for selling medical devices and the delivery of medical devices. Therefore, when the subject matter of the claims of each Group as a whole is reviewed,

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Groups I, II, and III do not have separate utility as the electronic sale of automobile parts or other commodity. As such, the Examiner has failed to meet the burden under MPEP §806.05(d). Therefore, Groups I, II, III, and IV are not independent or distinct. As such, Groups I, II, III and IV necessitate rejoinder.

Nevertheless, assuming *arguendo* that Groups I, II, and III do have separate utility, the Examiner has failed to show that Group I has separate utility from Groups II and III and that Group II has separate utility from Group III. As such, the Examiner has not met the requirements of MPEP §806.05(d) and, therefore, a restriction of Groups I, II, and III is improper. In fact, the Examiner failed to address Groups I, II, and III as separately distinct in any way. Simply, the Examiner has not shown that the inventions are independent or distinct as claimed. Accordingly, assuming that Groups I, II, and III are distinct from Group IV, Groups I, II, and III are not distinct from each other. At a minimum, Groups I, II, and III must be rejoined.

As to whether there is a serious burden on the Examiner if restriction is not required, the Examiner asserts "because these inventions...have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper." However, the Examiner has classified each Group in the exact same class – class 705. It appears that the Examiner is hinging his assertions on the subclassification of each Group. That is, the Examiner classified Group I in subclass 26, Group II in subclass 1, Group III in subclass 7, and Group IV in subclass 36. That is, Groups I, II, II and IV were subclassified in the subclass of "electronic shopping (e.g., remote ordering)," "automated electrical financial or business practice or management arrangement," "operations research," and "portfolio selection, planning or analysis," respectively.

Applicant strongly questions whether these "distinct" subclassifications are appropriate. For example, Group I is "a method for designing an electronic transaction system" but is subclassified as "electronic shopping (e.g., remote ordering)." Applicant is uncertain how claims directed "a method for designing an electronic transaction system" acquires separate subclassification from Group II, which is drawn to a method of forming a proposal for doing business on a global communication network" and is

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subclassified as "automated electrical financial or business practice or management arrangement."

Additionally, the Examiner stated that Group III is "drawn to a method of conducting electronic commerce over a global network" but subclassified the Group as "operations research." How is "a method of conducting electronic commerce over a global network" related to "operations research?" Further, how is Group III, "a method of conducting electronic commerce over a global network," different from a Group I, which is subclassified as "electronic shopping (e.g., remote ordering)" or Group II, which is subclassified as automated electrical financial or business practice or management arrangement?"

Similarly, the Examiner stated that Group IV is "drawn to a method of electronic sale of medical devices." How is a Group IV, "a method of electronic sale of medical devices," deemed in a subclass for "portfolio selection, planning or analysis?" Further, how is a Group IV, "a method of electronic sale of medical devices," different from a Group I, which is subclassified as "electronic shopping (e.g., remote ordering)" or Group II, which is subclassified as automated electrical financial or business practice or management arrangement?" The Examiner's subclassifications are completely inconsistent. Simply, Group I, II, III and IV are not distinct and cannot properly be given different subclassifications.

It appears to Applicant that the most relevant subclassification is subclass 1 -- automated electrical financial or business practice or management arrangement. That is, Applicant does not see a basis for subclassification of any of the Groups in subclasses designated for "electronic shopping (e.g., remote ordering)," "operations research," and "portfolio selection, planning or analysis." Due to the similar nature of the claims, as exemplified by the common classification, Applicant does not see any basis for asserting that without restriction a search of all Groups would constitute a serious burden. In fact, the claims and the Groups are so related that the Examiner really should do the very same breadth of search for each. Anything less, would be inadequate.

Nevertheless, the Examiner states that "[b]ecause these inventions are distinct for the reasons given above and the search required for Groups I, II or III is not required for

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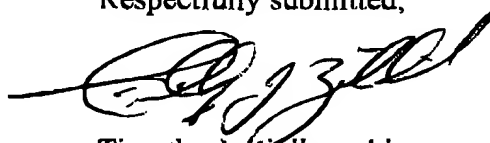
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Group IV." However, the Examiner provides no support for this assertion. As previously stated, it appears that the Examiner's basis for distinction between Groups I, II, and III from Group IV is that the preamble of Group IV calls for "electronic sale of medical devices." However, Applicant has previously pointed out that the Examiner must consider the Groups as a whole and the specific elements/limitations contained therein. The Examiner cannot just compare preambles of the independent claims. As shown, claims 3, 4, 5, 8, and 10 of Group I all call for medical devices/equipment; claims 13 and 15 of Group II call for selling medical devices and the delivery of medical devices, respectively; and claims 19 and 20 of Group III also call for selling medical devices and the delivery of medical devices. Therefore, a search of the subject matter of Group IV will necessarily include a search of the subject matter of Groups I, II, and III.

Applicant believes Groups I, II, III and IV must be rejoined because the Examiner has not shown: (1) separate classification of the identified inventions, (2) that the inventions have acquired a separate status in the art, or (3) that the inventions require differing fields of search. Specifically, the Examiner has made no attempt to meet the requirements for restriction between Groups I, II and III. Therefore, Groups I, II, and III must be rejoined. Furthermore, Applicant has shown that the restriction of Group IV is improper. Therefore, Groups I, II, III, and IV must be rejoined.

The Examiner is invited to call the undersigned to discuss this Response or any other matters regarding this application.

Respectfully submitted,



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